

REMARKS

I. PRELIMINARY REMARKS

No claims have been amended. Claims 28-34 have been added. Non-elected claims 10-27 have been canceled. Claims 1-9 and 28-34 remain in the application. Claims 10-27 have been withdrawn from consideration. Reexamination and reconsideration of the application, as amended, are respectfully requested.

II. DOUBLE PATENTING REJECTION

Claim 1 has been provisionally rejected under the judicially created doctrine of obviousness-type double patenting. Applicant respectfully submits that the provisional obviousness-type double patenting rejection has been obviated by the Terminal Disclaimer attached hereto.¹

III. PRIOR ART REJECTIONS

A. The Rejection

Claims 1-8 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of U.S. Patent No. 5,584,872 to LaFontaine (the LaFontaine '872 patent) and U.S. Patent No. 5,891,134 to Goble et al. (the Goble '134

¹ Applicant notes for the record that the filing of a Terminal Disclaimer serves only to remove the obviousness-type double patenting rejection and raises neither a presumption, nor an estoppel, with respect to the merits of the rejection. See *Quad Environmental Technologies v. Union Sanitation District*, 20 USPQ2d 1393, 1394-95 (Fed. Cir. 1991).

patent).² Claim 9 has been rejected under 35 U.S.C. § 103 as being unpatentable over the LaFontaine '872 patent, the Goble '134 patent and U.S. Patent No. 5,688,267 to Panescu (the Panescu '267 patent). The rejections under 35 U.S.C. § 103 are respectfully traversed. Reconsideration thereof is respectfully requested.

B. The Claimed Combinations

Independent claim 1 calls for a combination of elements comprising "a shaft," "a plurality of energy transmission devices supported on the shaft" and "a tissue cooling apparatus supported on the shaft including an outer member positioned about the plurality of energy transmission devices such that a continuous fluid transmission space is defined therebetween having an inlet and an outlet." Claims 2-9 depend from independent claim 1 and by definition include, *inter alia*, the combination of elements recited in claim 1.

C. The LaFontaine '872 And Goble '134 Patents

The LaFontaine '872 patent discloses a variety of different RF energy treatment devices. Each of the treatment devices includes a single electrode and a structure, within which the electrode is recessed, for conveying an electrolytic fluid through the electrode to the tissue being treated. Conveying electrolytic fluid to the tissue serves two primary purposes – (1) establishing an electrical path from the electrode to the tissue, and (2) cooling the tissue so that deeper lesions may be formed. [Column 8, lines 13-32.]

The Goble '134 patent discloses various multi-electrode tissue heating devices. Each of these devices illustrated in Figures 3-6 and 8 includes a closed bladder 18 which is inflated with conductive fluid during tissue heating procedures. Current passes

² Applicant notes that the Examiner indicated by telephone that the citation of the LaFontaine '267 patent in the Office Action is a typographical error and that the

through the conductive fluid from electrode to electrode, thereby heating the fluid as well as the tissue in contact with the bladder. The Goble '134 patent also discloses that multiple electrodes 24a-c/26a-c (Figures 3-6) may be individually controlled in order to control the temperature of the bladder 18. More specifically, the Goble '134 patent discloses that individual control of the electrodes 24a-c/26a-c may be used to generate more heat in one portion of the bladder 18 than others, and may also be used to induce fluid circulation within the bladder. [See column 8, lines 54-57; column 8, line 66 to column 9, line 16; and column 9, lines 17-34.] Similarly, individually controlling the return electrodes 106 (Figure 8) allows individual portions of the bladder 18 to be heated.

D. Discussion

In *Winner International Royalty Corp. v. Wang*, 48 USPQ2d 1139, 1144 (Fed. Cir. 1998), the Federal Circuit reiterated the fundamental rule that "it is insufficient to prove that at the time of the claimed invention, the separate elements of the device were present in the known art." To the contrary, "there must have been some **explicit** teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention." *Id.* [Emphasis added.] Thus, "[o]ne cannot use hindsight reconstruction to pick and chose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Applicant respectfully submits that the present rejections are examples of the hindsight reconstruction prohibited by the Federal Circuit.

In contrast to the combination of elements set forth in independent claim 1, and as noted in the Office Action, the LaFontaine '872 patent does not disclose a treatment device with a plurality of energy transmission devices. The Office Action relies of the teachings of the Goble '134 patent to remedy this deficiency in the LaFontaine '872 patent. Applicant respectfully submits that it fails to do so.

The fluid emitting devices disclosed in the LaFontaine '872 patent transmit fluid through a single electrode ***on its way out*** of the device in order to establish an electrical path between the electrode and tissue and to cool the tissue. The Goble '134 patent, on the other hand, discloses that multiple electrodes may be used in devices that include a ***closed bladder*** to control the temperature of different portions of the bladder and to cause the fluid within the bladder to circulate after bladder has been filled. There is nothing in the Goble '134 patent which even remotely suggests that its teachings are applicable to a fluid emitting device such as that disclosed in the LaFontaine '872 patent. For example, applicant is not aware of any reason to heat different portions of the LaFontaine fluid emitting devices to different temperatures, or to induce fluid circulation within the fluid emitting devices, as is done in the Goble closed bladders. Nor has the Office Action provide indication as to ***why*** one of skill in the art would have been motivated by the Goble '134 patent to add multiple independently controllable electrodes to a device that simply emits conductive fluid from its distal end. As such, the Office Action has merely pieced together elements from disparate references and has failed to establish an essential component of any obvious holding.³

As the LaFontaine '872 and Goble '134 patents fail to teach or suggest the combination of elements recited in independent claim 1, whether viewed alone or in combination, applicant respectfully submits that the rejection of claims 1-8 under 35 U.S.C. § 103 is improper and must be withdrawn.

Turning to the rejection of dependent claim 9, applicant respectfully submits that the Panescu '267 patent fails to remedy the deficiencies in the proposed LaFontaine '872/Goble '134 combination with respect to independent claim 1. As such, dependent claim 9 is patentable for at least the same reasons as independent claim 1 and the rejection of claim 9 under 35 U.S.C. § 103 should also be withdrawn.

³ "[A] showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding.'" *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

IV. NEWLY PRESENTED CLAIMS 28-34

Newly presented claims 28-34 depend, either directly or indirectly, from independent claim 1 and, accordingly, are patentable for at least the same reasons as independent claim 1.

V. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

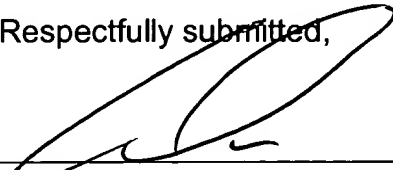
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

6/3/03
Date

Henricks, Slavin & Holmes LLP
840 Apollo Street, Suite 200
El Segundo, CA 90245
(310) 563-1458
(310) 563-1460 (Facsimile)

Respectfully submitted,



Craig A. Slavin
Reg. No. 35,362
Attorney for Applicant